

## **REMARKS**

In the Office Action, the Examiner rejected claims 1-28. By this paper, claims 1, 2, 14, 15, 19, 20, and 26 are amended as indicated above. No new subject matter is added by the amendments. In view of the amendments and the following remarks, Applicant respectfully requests reconsideration and allowance of all pending claims.

### **Claim Rejections under 35 U.S.C. § 112, Second Paragraph**

In the Office Action, the Examiner rejected claims 25 and 28 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regard as the invention. In particular, the Examiner stated the term “special purpose computer” recited in claims 25 and 28 is indefinite. Office Action, page 3. Applicant respectfully traverses the rejection.

### ***Legal Precedent***

Although the Examiner may take exception to the terms used in the claims, the patentee may be his own lexicographer. *Ellipse Corp. v. Ford Motor Co.*, 171 U.S.P.Q. 513 (7<sup>th</sup> Cir. 1971), *aff’d*, 613 F.2d 775 (7<sup>th</sup> Cir. 1979), *cert. denied*, 446 U.S. 939 (1980). The Examiner is also reminded not to equate breadth of a claim with indefiniteness. *In re Miller*, 441 F.2d 689, 169 U.S.P.Q. 597 (CCPA 1971).

Additionally, during patent examination, the pending claims must be given an interpretation that is *reasonable* and *consistent* with the specification. *See In re Prater*, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); *In re Morris*, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir.

1997); see also M.P.E.P. § 2111 (describing the standards for claim interpretation during prosecution). Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. See *In re Cortright*, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); see also M.P.E.P. § 2111. That is, recitations of a claim must be read as they would be interpreted by those of ordinary skill in the art. See *Rexnord Corp. v. Laliram Corp.*, 60 U.S.P.Q.2d 1851, 1854 (Fed. Cir. 2001); see also M.P.E.P. § 2111.01. In summary, an Examiner, during prosecution, must interpret a claim recitation as one of ordinary skill in the art would reasonably interpret the claim in view of the specification. See *In re American Academy of Science Tech Center*, 70 U.S.P.Q.2d 1827 (Fed. Cir. 2004).

***The term “Special Purpose Computer” is definite***

Applicant respectfully asserts that the term “special purpose computer” is definite and would be clearly understood by one of ordinary skill in the art. Specifically, Applicant asserts that the words modifying phrase “special purpose” and the object “computer” are clear on their face and easily understood according to their ordinary meaning. Similarly, the term “special purpose computer” is clear on its face and would be understood by one of ordinary skill in the art as being a computer configured to perform specific tasks, as opposed to an all-purpose or general purpose computer. Furthermore, as pointed out by the Examiner, the specification gives specific examples of a special purpose device such as “a dedicated modeling station employing ASIC’s or special purpose processors,” which may be used in such a special purpose computer. See Office Action, page 3. Therefore, Applicant believes that claims 25 and 28, as originally presented, are sufficiently clear and definite as to meet the requirements of the second paragraph of Section

112. As such, the Applicant respectfully requests withdrawal of the Section 112 rejection of claims 25 and 28.

**Claim Rejections Under 35 U.S.C. § 101**

In the Office Action, the Examiner rejected claims 14-18 and 26-28 under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the Examiner stated:

Claims 14-18 are interpreted as being software, per se. Although the claim is directed to a tangible, machine-readable media comprising code, the Applicant has not set forth any tangible embodiments of the media. Claim 26 is directed to a method of loading a computer program onto a device.

Office Action, page 3. The Applicant respectfully traverses this rejection.

***Legal Precedent***

According to the Supreme Court, congress intended statutory subject matter to “include anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09; 206 U.S.P.Q. 193, 197 (1980). Indeed, exclusions of statutory subject matter are limited to laws of nature, natural phenomena and abstract ideas. *See Diamond v. Diehr*, 450 U.S. 175, 185; 209 U.S.P.Q. 1, 7 (1981). Other than these specific exceptions, therefore, nearly anything man made is statutorily patentable subject matter under 35 U.S.C. §101.

In determining when process or method claims include statutory subject matter, the Supreme Court in *Diehr* stated that “[t]ransformation and reduction of an article ‘to a different

state or thing' is the clue to the patentability of a process claim that does not include particular machines." *See id.* 450 U.S. at 183-185, 209 U.S.P.Q. at 6. In addition to the Supreme Court's transformation and reduction test, the Federal Circuit has developed a second test which may also be used to determine if a claim recites statutory subject matter, namely does the claim produce a "useful, concrete, and tangible result." *In re Alappat*, 31 U.S.P.Q.2d 1545, 1557 (Fed. Cir. 1994) (*en banc*). The Federal Circuit further elaborated on this second test by holding that one must look to "the essential characteristics of the subject matter, in particular, its practical utility." *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 47 U.S.P.Q.2d 1596, 1602 (Fed. Cir. 1998).

However, explaining this "useful, concrete, and tangible" test, the Federal Circuit has stated "the dispositive inquiry is whether the claim *as a whole* is directed to statutory subject matter." *In re Alappat*, 31 U.S.P.Q.2d at 1557. Indeed, there has been no requirement from Congress, the Supreme Court, or the Federal Circuit mandating that a *specific final result* be shown for a claim to qualify under Section 101. *See id.* Rather, the Federal Circuit has specifically stated "the *Alappat* inquiry simply requires an examination of the contested claims to see if the claimed subject matter *as a whole* is a disembodied mathematical concept representing nothing more than a 'law of nature' or an 'abstract idea,' or if the mathematical concept has been reduced to *some practical application rendering it 'useful'.*" *AT&T Corp. v. Excel Communications, Inc.*, 50 U.S.P.Q.2d 1447, 1451 (Fed. Cir. 1999) (emphasis added). Therefore, if a claim meets either the transformation and reduction test put forth by the Supreme Court, or if

the claim, read as a whole and in light of the specification, produces any useful, concrete, and tangible result, the claim meets the statutory requirements of Section 101. *See id.*

***Claims 14-18***

Independent claim 14 is directed to a tangible, machine-readable media comprising code, as noted by the Examiner. The tangible machine readable media is a computer element defining structural and functional interrelationships between the code and the rest of the computer. *See* M.P.E.P., section 2106.01 (stating a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and thus *is statutory*) citing *In re Lowry*, 32 U.S.P.Q.2d 1031, 1035 (Fed. Cir. 1994). Furthermore, those skilled in the art would readily understand and know the various particular, tangible media which meet the limitations of the claim and, as discussed above, the claims should be given an interpretation consistent with the interpretation that those skilled in the art would reach. *See In re Cortright*, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999). As such, Applicant asserts that claims 14-18 are directed to statutory subject matter and respectfully request withdrawal of the rejection under Section 101. However, if the Examiner chooses to maintain the present rejection, the Applicant respectfully requests that the Examiner provide an explicit finding as to the level of skill in the art which the Examiner attributes to a hypothetical practitioner. Likewise, the Applicant requests that the Examiner detail why such a practitioner of the attributed level of skill would be unable to understand with

definiteness the bounds of the recited language in view of the specification and the knowledge attributed to the practitioner based on their skill.

***Claim 26***

Contrary to the Examiner's assertion, claim 26 is directed to a method of manufacturing a device for modeling a communication system. Methods of manufacturing are clearly statutory subject matter. *Cf. State Street Bank*, 47 U.S.P.Q.2d at 1596. As such Applicant asserts that claim 26 is statutory subject matter under Section 101 and respectfully requests withdrawal of the rejection under Section 101.

**Claim Rejections under 35 U.S.C. § 102**

In the Office Action, the Examiner rejected claims 1-28 under 35 U.S.C. § 102(b) as being anticipated by Earnshaw et al., "*A Parallel Simulator for Performance Modelling of Broadband Telecommunication Networks*," published in Proceedings of the 1992 Winter Simulation Conference (hereafter referred to as "the Earnshaw reference"). Applicant respectfully traverses this rejection.

***Legal Precedent***

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *See Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir.1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *See In re Bond*, 15 U.S.P.Q.2d 1566 (Fed. Cir.1990).

That is, the prior art reference must show the *identical invention* “*in as complete detail as contained in the ... claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989) (emphasis added). Thus, for anticipation, the cited reference must not only disclose all of the recited features but must also disclose the *part-to-part relationships* between these features. *See Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 486 (Fed. Cir.1984). Accordingly, Applicant need only point to a single element or claimed relationship not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. A *strict correspondence* between the claimed language and the cited reference must be established for a valid anticipation rejection.

Furthermore, as discussed above, during patent examination, the pending claims must be given an interpretation that is *reasonable* and *consistent* with the specification. *See In re Prater*, 162 U.S.P.Q. 541, 550-51 (C.C.P.A. 1969); *In re Morris*, 44 U.S.P.Q.2d 1023, 1027-28 (Fed. Cir. 1997); see also M.P.E.P. § 2111 (describing the standards for claim interpretation during prosecution). Indeed, the *specification* is “the primary basis for construing the claims.” *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (citations omitted). It is usually dispositive. *See id.* Interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *See In re Cortright*, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); see also M.P.E.P. § 2111. That is, recitations of a claim must be read as they would be interpreted by those of ordinary skill in the art. *See Rexnord Corp. v. Laliram Corp.*, 60 U.S.P.Q.2d 1851, 1854 (Fed. Cir. 2001); see also M.P.E.P. § 2111.01. In summary, an

Examiner, during prosecution, must interpret a claim recitation as one of ordinary skill in the art would reasonably interpret the claim in view of the specification. *See In re American Academy of Science Tech Center*, 70 U.S.P.Q.2d 1827 (Fed. Cir. 2004).

***The Earnshaw reference fails to disclose all the elements of the present claims***

Claim 1 recites, *inter alia*, “distributing the plurality of simulated messages ... based on at least a simulated mobile switching center architecture; generating a plurality of simulated outgoing messages based upon at least the plurality of simulated messages and the simulated call model.” Claims 14 and 26 recite, *inter alia*, “code adapted to distribute the plurality of simulated messages ... based on at least a simulated mobile switching center architecture; code adapted to generate a plurality of simulated outgoing messages based upon at least the plurality of simulated messages and the simulated call model.” Claim 19 recites, *inter alia*, “a processor configured to execute code adapted to: distribute the plurality of simulated messages...based on at least a simulated mobile switching center architecture; generate a plurality of simulated outgoing messages based upon at least the plurality of simulated messages and the simulated call model.”

In contrast, the Earnshaw reference does not disclose a mobile switching center architecture or generating a plurality of outgoing messages. Specifically, with regards to the mobile switching center, the Earnshaw reference does not disclose distributing the plurality of simulated messages based on at least a simulated mobile switching center architecture, as set forth in claims 1, 14, 19, and 26. In rejecting the claims, the Examiner refers to the following section of the Earnshaw reference:



The use of parallel simulation introduces many additional issues into the simulation design process. These include the hardware architecture, the decomposition approach used to produce the parallel software processes, mapping these processes onto the processors and the synchronization of the resulting parallel simulations.

See Office Action, page 5 (citing Earnshaw, page 1265, column 2, second full paragraph, lines 1-6). However, in context, Applicant believes that this section refers to the hardware architecture of the parallel *simulator*, i.e., the architecture of the computer to workstation running the simulation, not a *simulated mobile switching center architecture* as set forth in the claims. Indeed, the Earnshaw reference fails to disclose a mobile switching center architecture, let alone distributing the plurality of simulated messages based upon at least a simulated mobile switching center architecture, as set forth in claims 1, 14, 19, and 26. Therefore, for at least this reason, the Earnshaw reference fails to disclose all the elements of the present claims and cannot anticipate the present application. Accordingly, Applicant respectfully requests the withdrawal of the rejection of claim 1, 14, 19, and 26 under section 102.

Additionally, the Earnshaw reference fails to disclose generating a plurality of simulated outgoing messages based upon at least the plurality of simulated messages and the simulated call model, as set forth in claims 1, 14, 19, and 26. The Earnshaw reference only discloses loading tasks and running the specific tasks loaded. See Earnshaw, page 1368, column 2, last paragraph. Indeed, even construed in a light most favorable to the Examiner's position, the Earnshaw reference only discloses the passing of messages from one node to another. See *id.* As such, Applicant respectfully asserts that the Earnshaw reference does not disclose generating a plurality

of simulated outgoing messages based upon the plurality of simulated messages and the call model. Therefore, for at least this reason, Applicant respectfully requests withdrawal of the rejection of claims 1, 14, 19, and 26 under Section 102.

Furthermore, Applicant respectfully asserts that the Earnshaw reference fails to disclose a call model as recited in the claims 1, 14, 19, and 26. In rejecting claims 1, 14, 19, and 26, the Examiner pointed to the event list of the Earnshaw reference as being a call model. *See* Office Action, page 4 (citing Earnshaw, page 1368, section 3.2.4, lines 1-4). However, Applicant respectfully asserts that the event list, as set forth in the Earnshaw reference, is nothing more than a list of events for the simulator to execute and is most equivalent to the plurality of simulated messages which is separately recited in the present claims. Indeed, there is nothing in the Earnshaw reference that can reasonably be considered the equivalent of the call model as set forth in the claims and described in the specification. *See* Specification, pages 10-11. Therefore, the Earnshaw reference does not disclose both the plurality of simulated messages and the call model, and it would be impossible for the Earnshaw reference to generate a plurality of simulated outgoing messages based upon at least the plurality of simulated messages and the simulated call model, as set forth in the claims. Accordingly, for at least this additional reason, Applicant respectfully requests withdrawal of the rejection of claims 1, 14, 19, and 26 under Section 102.

In view of the foregoing reasons, Applicant respectfully asserts that the Earnshaw reference fails to disclose all the elements of claims 1, 14, 19, and 26 and cannot support a

rejection under Section 102. Accordingly, Applicant request withdrawal of the Section 102 rejection and allowance of claims 1, 14, 19, and 26, as well as all claims depending therefrom.

**Claim Rejections under 35 U.S.C. § 103(a)**

In the Office Action, the Examiner rejected claims 9, 11, 24, and 27 under 35 U.S.C. § 103(a) as being unpatentable over the Earnshaw reference as applied to claims 1-8, 10, 12-23, 25-26, and 28 above in view of Scoggins et al., "*A Teletraffic Simulator for Circuit Switched and Signaling Intelligent Network with SS7*," published in the Proceeding of the 1991 Winter Simulation Conference (hereafter referred to as "the Scoggins reference"). The Applicant respectfully traverses this rejection.

***Legal Precedent***

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (B.P.A.I. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the

claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

***The Scoggins reference fails to obviate the deficiencies of the Earnshaw reference***

The Scoggins reference fails to obviate the deficiencies of the Earnshaw reference with respect to independent claims 1, 14, 19, and 26. Specifically, the Scoggins reference fails to disclose a distributing a plurality of simulated messages based on at least a simulated mobile switching center architecture or generating a plurality of outgoing simulated messages based upon at least the plurality of simulated messages and the simulated call model. As such, the Earnshaw reference and the Scoggins reference, taken alone or in hypothetical combination, fail to disclose all the elements set forth in the independent claims 1, 14, 19, and 26. Accordingly, Applicant respectfully requests withdrawal of the Section 103 rejection and allowance of all pending claims based on their dependency from claims 1, 14, 19, and 26.

**Conclusion**

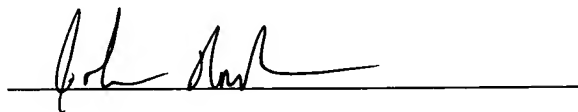
The Applicant respectfully submits that all pending claims should be in condition for allowance. However, if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

***General Authorization for Extensions of Time***

In accordance with 37 C.F.R. § 1.136, Applicants hereby provide a general authorization to treat this and any future reply requiring an extension of time as incorporating a request therefor. Furthermore, Applicant authorizes the Commissioner to charge the appropriate fee, as well as any additional fees that may be currently due, to Deposit Account No. 06-1315; Order No. Pirrone 1 (LUCW:0007).

Respectfully submitted,

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